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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/526,346	03/02/2005	Joseph Anthony Mancini	MC057YP	3029				
210 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907	7590 10/10/2007		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">JAVANMARD, SAHAR</td></tr></table>		EXAMINER		JAVANMARD, SAHAR	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/526,346

Applicant(s)

MANCINI ET AL.

Examiner

SAHAR JAVANMARD

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                        |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2 March, 2005</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

The Office Action is in response to the 371 of PCT/US03/27612 filed September 2, 2003. Amended claims 1-8 are being examined on the merits herein.

### **Objections**

Claim 4 is objected to. The hydroxyl group in the structure is missing the hydrogen. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Guay et al. (US Patent No. 5,710,170).

Guay teaches compounds and pharmaceutical compositions of formula I (column 2, lines 45-55) for the treatment of diseases by raising the level of cAMP through the inhibition of phosphodiesterase IV (PDE IV) (column 1, lines 8-11).

The reference further teaches that the compounds may also elevate cAMP in lymphocytes and thereby suppress unwanted lymphocyte activation in immune-based diseases such as rheumatoid arthritis, ankylosing spondylitis, transplant rejection and graft versus host disease (column 7, lines 45-53), meeting the limitations of claims 1, 2, and 4.

Thus Guay anticipates the instant claims.

Claims 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Amschler et al. (US Patent No. 5,712,298).

Amschler teaches a series of benzamides as having PDE inhibiting properties, in particular PDE-IV (column 11, line 35), specifically the compound N-(3,5-dichloropyrid-4-yl)-3- cyclopropylmethoxy-4-difluoromethoxybenzamide (column 9, lines 40-41).

Amschler further teaches that on account of their PDE-inhibiting properties, the compounds can be employed in human and veterinary medicine as therapeutics for a number of diseases (column 1, lines 52-54) including rheumatoid arthritis (column 12, lines 2). The limitation of claim 6 is met.

Thus Amschler anticipates the instant claim.

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Claims 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Deschenes et al. (US Patent No. 6,410,563B1).

Deschenes teaches substituted 8-arylquinolines, wherein the aryl group at the 8-position contains a substituent substituted-alkenyl group have been found to exhibit biological activity as PDE4 inhibitors (column 1, lines 10-15) as represented by formula I (column 3, lines 35-50). Deschenes specifically teaches the compound recited in claim 5 of the application (column 141, lines 25-45).

Deschenes further teaches that the compounds can be used in the treatment of animals for a number of diseases including rheumatoid arthritis (column 22, line 6). The limitation of claims 3 and 5 are met.

Thus Deschenes anticipates the instant claims.

Claims 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Guay et al. (WO 03/018579 A1).

Guay teaches alkyne-aryl compounds represented by formula I (page 3) found to exhibit activity as PDE4 inhibitors useful in the treatment of asthma and inflammation (abstract, page 1, lines 10-14), specifically rheumatoid arthritis (page 4, line 8). Guay explicitly teaches the compound recited in claim 8 of the application (page 40, example 16). The limitation of claims 7 and 8 are met.

Thus Guay anticipates the instant claims.


**Conclusion**

Claims 1-8 are not allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAHAR JAVANMARD whose telephone number is (571) 270-3280. The examiner can normally be reached on 8 AM-5 PM MON-FRI (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY STUCKER can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

A handwritten signature in black ink, appearing to be 'SJ' followed by a stylized flourish.A handwritten signature in black ink, appearing to be 'JS' followed by a stylized flourish.

JEFFREY STUCKER  
SUPERVISORY PATENT EXAMINER